REMARKS

This communication is a full and timely response to the non-final Office Action dated March 19, 2010. Claims 11-20 are pending, of which claims 1, 18, and 19 are the independent claims. By this communication, claims 1, 18, and 19 are amended. Favorable reconsideration of this application in view of the following Remarks is respectfully requested.

Preliminary Matters

The Applicant gratefully acknowledges the courtesies extended by Examiner Kuddus and Examiner Padmanabhan in the personal interview with the Applicants' representative on June 8, 2010, wherein the differences between the claimed subject matter and the cited references were discussed. No agreement was reached[1].

Claim Objections

Claims 11-17 are objected to for minor informalities. On page 2 of the Office Action, the Examiner states that claim 11 should read as, "A computer implemented method of backing up." The Examiner further alleges that claims 12 and 13 are duplicate claims. The Applicants respectfully traverse these objections.

Regarding claim 11, the Applicants submit that claim 11 is entirely clear in its meaning and does not require the insertion of "computer implemented" in the preamble for the following reasons. The Applicants submit that each method limitation pertains to a method step specifically performed by a "<u>mobile communication device</u>." The insertion of

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[1] Although the Examiner appeared to believe that claim amendments would be necessary to overcome the cited prior art, and although the claims have been amended in response to the non-final Office Action dated March 19, 2010, at no point during the Examiner's Interview, did the Applicants' representative agree to amend the claims in order to further clarify the claimed subject matter or to overcome any claim rejections.

"computer implemented", therefore, would be neither necessary nor appropriate as alleged by the Examiner. As such, the Applicants respectfully submit that the objection be withdrawn.

Regarding claims 12 and 13, the Applicants respectfully submit that these claims are not duplicate claims. Claim 12 recites, *inter alia*, "...<u>the network server</u> implements a countdown of a period of time and sends a resume signal to a chip card...." Claim 13 recites, *inter alia*, "...<u>the mobile communication device</u> implements a countdown of a period of time and sends a resume signal to a chip card...." As is clearly seen, claims 12 and 13 are not mere duplicates as they pertain to two different components. Therefore, the Applicants respectfully submit that the objection be withdrawn.

Rejection to the Claims

Claim 18 stands rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory matter.

Claims 11, 18 and 19 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Johan Sarskog (WO 01/62029) ("*Sarskog*").

Claims 11, 18 and 19 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Van Reenen et al (WO 03/037015) ("*Van Reenen*").

Claims 11-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dormehl et al (WO 03/007639) ("*Dormehl*") and further in view of Jouenne et al (U.S. Patent No. 6,286,085) ("*Jouenne*").

These rejections are respectfully traversed.

Claim Rejections under 35 U.S.C. § 101

Claim 18 is rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory matter.

The Examiner alleges that claim 18 is directed to non-statutory subject matter because "'a server' and a 'means for' are being recited, without having any hardware component." (Office Action, page 2). The Applicants do not agree with the Examiner, and while not acquiescing to this rejection, have nonetheless amended claim 18 to specifically recite a "server device" (i.e., a hardware component) and to remove the "means for" recitation in order to advance prosecution of this application. Thus, the Applicants respectfully submit that claim 18 complies with 35 U.S.C. § 101 and request that the rejection of claim 18 be withdrawn.

Claim Rejections under 35 U.S.C. § 102(b)

In numbered paragraph 4 on page 3 of the Office Action, the Examiner rejected claim 11 (as well as claims 18 and 19) as allegedly being anticipated by *Sarskog*. The Applicants respectfully submit that *Sarskog* cannot support a rejection of claim 11 under 35 U.S.C. § 102(b) because the reference fails to disclose every claim feature. (*See* MPEP § 2131).

Independent claim 11, as amended, recites, *inter alia*, "A method of backing up personal data of a wireless communication network subscriber...wherein said method includes..., once the mobile communication device has *divided a batch of data to be backed up into a plurality of subsets, prepared a first subset of data from the plurality of subsets and transmitted the first subset of data to a network server for backing up, the backup is delayed by a predetermined period of time...and the backup of at least one other subset of data from the plurality of subsets subsequent to the first subset of data is resumed at the end of said*

predetermined period of time. The Applicants respectfully submit that _Sarskog_ fails to disclose or suggest a method of backing up personal data as recited in claim 11.

Sarskog discloses a method of backing up stored information in an SIM card of a mobile telephone via a mobile telephone system to a memory device of a computer. In contrast, however, to the presently claimed method, _Sarskog_ discloses that **all** of the information stored within the SIM card is transferred to the memory device at predetermined time intervals. The reference is entirely silent with respect to <u>first dividing the information</u> in the SIM card into subsets and then individually sending each subset at predetermined times. The presently claimed method overcomes problems associated with methods of backing up data, such as that of _Sarskog_ where **ALL** of the stored information is transmitted at one time, and then transmitted again at another time, and so on. The method, as recited in claim 11, overcomes such problems by dividing a batch of data into a plurality of subsets and delaying backup for a certain period of time in order to free the mobile device for the user. Therefore, the method as disclosed by _Sarskog_ is not analogous to that of the claimed method and therefore cannot attain the same results.

For at least the reasons set forth above, the Applicants respectfully submit that _Sarskog_ fails to disclose or suggest the method as recited in claim 11.

To properly anticipate a claim, the document must disclose, explicitly or implicitly, each and every feature recited in the claim. See Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For the reasons set forth above, the Applicants respectfully submit that _Sarskog_ does not meet this requirement.

Accordingly, the Applicants respectfully submit that independent claim 11 is patentably distinct from _Sarskog_. Thus, the Applicants respectfully request that the rejection be withdrawn.

Moreover, based at least upon their dependence from claim 11, claims 12-17 are also patentably distinct from *Sarskog*.

Independent claims 18 and 19, although different in scope, recite at least some of the same distinguishing features noted above with respect to claim 11. Therefore, arguments similar to those in connection with claim 11 are also applicable to claims 18 and 19. Accordingly, the Applicants respectfully submit that independent claims 18 and 19 are patentably distinct from *Sarskog* and request that the rejection be withdrawn. Based at least upon its dependence from independent claim 19, claim 20 is also patentably distinct from *Sarskog*.

Claim Rejections under 35 U.S.C. § 102(e)

In numbered paragraph 5 on page 4 of the Office Action, the Examiner rejected claim 11 (as well as claims 18 and 19) as allegedly being anticipated by *Van Reenen*. The Applicants respectfully submit that *Van Reenen* cannot support a rejection of claim 11 under 35 U.S.C. § 102(e) because the reference fails to disclose every claim feature. (*See* MPEP § 2131).

Van Reenen discloses a method of backing up information in a mobile phone in which data is transmitted from the device to a storage means via a network. Like *Sarskog* (discussed above), *Van Reenen*, discloses backing up information such that **ALL** the information stored within the mobile phone is initially backed up. Thereafter, information can be backed up in two ways. If the device has sufficient memory, application software can identify ONLY CHANGES that have been made to the data since the last back up, and ALL of the changes are transmitted to a memory device/backup facility. These changes, once received in the memory device, are saved AT THE BACK UP FACILITY, in files/patches. In another embodiment, ALL the information is sent at each back up

session. Therefore, like *Sarskog* (discussed above), *Van Reenen* is entirely silent with respect to <u>first dividing the information</u> saved in the mobile phone <u>into plurality of subsets,</u> sending a first subset from the plurality of subsets, waiting a predetermined amount of time, and then sending another subset from the plurality of subsets.

Moreover, the presently claimed method overcomes problems associated with methods of backing up data, such as that of *Van Reenan* where **<u>ALL</u>** of the stored information is transmitted at one time by dividing a batch of data into a plurality of subsets and delaying backup for a certain period of time in order to free the mobile device for the user. Therefore, the method as disclosed by *Van Reenen* is not analogous to that of the claimed method and therefore cannot attain the same results.

For at least the reasons set forth above, the Applicants respectfully submit that *Van Reenen* fails to disclose or suggest a method as recited in claim 11.

To properly anticipate a claim, the document must disclose, explicitly or implicitly, each and every feature recited in the claim. See Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For the reasons set forth above, the Applicants respectfully submit that *Van Reenen* does not meet this requirement.

Accordingly, the Applicants respectfully submit that independent claim 11 is patentably distinct from *Van Reenen*. Thus, the Applicants respectfully request that the rejection be withdrawn.

Moreover, based at least upon their dependence from claim 11, claims 12-17 are also patentably distinct from *Van Reenen.*.

Independent claims 18 and 19, although different in scope, recites at least some of the same distinguishing features noted above with respect to claim 11. Therefore, arguments

similar to those in connection with claim 11 are also applicable to claims 18 and 19.

Accordingly, the Applicants respectfully submit that independent claims 18 and 19 are

patentably distinct from *Van Reenen* and request that the rejection be withdrawn. Based at

least upon its dependence from independent claim 19, claim 20 is also patentably distinct

from *Van Reenen*.

Claim Rejections Under 35 U.S.C. § 103(a)

In numbered paragraph 6 on page 6 of the Office Action, the Examiner rejected

claims 11-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Dormehl* in view

of *Jouenne*.

The Applicants respectfully submit that the purported combination cannot support a

rejection of claim 11 because not only do the cited references (i.e., *Dormehl* and *Jouenne*),

taken alone or in proper combination, fail to disclose each element recited in claim 11, but

references fail to teach or suggest the claim limitations of which the Examiner alleges.

Dormehl discloses a mobile telephone data maintenance system that includes a

centralized computerized server configured to organize data received from mobile phones per

the request of a mobile telephone user (see p. 3, ll. 18-20). The server includes a

database/sub databases for the storage and organization of information. The reference in its

entirety refers to the database management system (i.e., organization of data within the

server) and does not in any way pertain to the manner in which information is transmitted

from the phone to the server. Specifically, the reference is entirely silent with respect to first

dividing information in the mobile phone into a plurality of subsets, sending a first subset

from the plurality of subsets, waiting a predetermined amount of time, and sending another

subset from the plurality of subsets. The Examiner alleges that *Dormehl* teaches preparing "a

first subset of data from among a batch of data to be backed up and transmitting the first subset of data to a network server for backing up," and cites p. 1, ll. 6-10 for support. However, the cited portion of the reference, upon which the Examiner relies, is entirely silent with respect to these features. In fact, the cited portion merely states, "a system aimed primary at providing a backup of data maintained in the memory of a mobile telephone such as a cellular telephone." The Applicants respectfully submit that this in no way can be construed as preparing "a first subset of data from among a batch of data to be backed up and transmitting the first subset of data to a network server for backing up", as the Examiner alleges. The reference in its entirety is silent with respect to this feature.

Furthermore, the Examiner alleges that *Dormehl* teaches that the "backup is delayed by a predetermined period of time, so as to free the mobile device for a user of the mobile communication device and the backup of at least one subset of data subsequent to the first subset of data is resumed at the end of said predetermined period of time," and contends that the claimed features are found on p. 3, ll. 18-28. The Applicants respectfully disagree. The cited portion of *Dormehl* is entirely silent with respect to these features. In fact, the portion, upon which the Examiner relies, teaches the backing up or replacing of data according to conditions set forth by mobile telephone user upon verification of a PIN or biometric identification. Nowhere in reference, let alone the cited portion, does *Dormehl* specifically teach backing up a *subset of data from a plurality of subsets, waiting a predetermined period of time, and resuming backup of another subset from a plurality of subsets subsequent to the first subset.*

Since the cited portions of *Dormehl,* upon which the Examiner relies, do not provide support for the Examiner's assertions, the Applicants respectfully request that if the rejection is not withdrawn in the next Office Action, that the Examiner specifically indicate where

support can be found for the Examiner's contentions. Specifically, the Applicants request the Examiner to identify:

1. Where *Dormehl* **specifically** teaches **dividing** data into a plurality of subsets and transmitting a first subset from the plurality of subsets to a network server for backing up; and

2. Where *Dormehl* **specifically** teaches **delaying backup** a predetermined period of time, so as to free the mobile device for a user of the mobile communication device, and then **resuming backup of at least one other subset** of data from the plurality of subsets subsequent to the first subset at the end of said predetermined period of time.

In the absence of such a showing, the Applicants respectfully submit that the rejection is unsupported, and cannot be maintained.

For at least the reasons set forth above, the Applicants respectfully submit that *Dormehl* fails to disclose or suggest a method as recited in claim 11 and as alleged by the Examiner.

Dormehl further fails to disclose or suggest asynchronous backup, to which the Examiner concedes.

To this end, the Examiner turns to *Jouenne* for allegedly teaching this feature. *Jouenne* discloses a database system including a plurality of stations configured communicate with one another such that data from one station can be "backed up" at another station by backing up either synchronously or asynchronously. However, like *Dormehl*, *Jouenne* is entirely silent with respect to first dividing information to be backed up into a plurality of subsets, sending a first subset from the plurality of subsets, waiting a predetermined amount of time, and sending another subset from the plurality of subsets, as recited in claim 11.

For at least the foregoing reasons, the Applicants respectfully submit that neither *Dormehl* nor *Jouenne*, taken individually or in combination, disclose or suggest the claimed features and, therefore, cannot support a *prima facie* case for rejecting claim 11 under 35 U.S.C. § 103(a). Thus, the Applicants respectfully request the rejection be withdrawn.

Independent claims 18 and 19, although different in scope, recite at least some of the same distinguishing features noted above with respect to claim 11. Therefore, arguments similar to those in connection with claim 11 are also applicable to claims 18 and 19. Accordingly, the Applicants respectfully submit that independent claims 18 and 19 are patentably distinct from the cited references and request that the rejection be withdrawn.

Moreover, based at least upon their dependence from an allowable independent base claims 12-17 and 20 are also patentably distinct from the cited references.

CONCLUSION

All of the stated grounds of rejection have been properly traversed. The Applicants therefore respectfully request that the Examiner reconsider and withdraw the presently outstanding rejection. The Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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